

CERTIFICATE OF ELECTRONIC SUBMISSION  
I hereby certify that this correspondence is being  
submitted electronically to the U.S. Patent and  
Trademark Office on September 12, 2007  
(Date of Transmission)

FRANK C. NICHOLAS (33,983)  
Name of applicant, assignee or registered representative  
/FRANK C. NICHOLAS/  
Signature  
September 12, 2007  
Date of Signature

PATENT  
**Case No.: AUS920000812US1**  
(9000/12)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:	)	
	)	
STEVEN M. FRENCH, ET AL.	)	Examiner: NGUYEN, THANH
	)	
Serial No.: 09/731,629	)	
	)	Group Art Unit: 2144
Filed: DECEMBER 7, 2000	)	
Title: METHOD AND SYSTEM FOR	)	Conf. No.: 1076
AUTOMATICALLY ASSOCIATING AN	)	
ADDRESS WITH A TARGET DEVICE	)	

**REPLY BRIEF**

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants herewith respectfully present their reply brief as follows:

The Examiner continues to misapply the law and misunderstand the facts. First, since the Examiner has not addressed the §112 ¶1 rejection of claims 1, 13, and 23, Appellants believe that the Examiner has withdrawn that rejection. To the extent that the Examiner wishes to maintain that rejection, the Board is directed to Appellants' earlier responses. Furthermore, the Examiner's responses to Appellants' arguments consist of nothing more than bland recitations of MPEP form language, and are utterly without any analysis or explanation.

For example, the Examiner's argument (p. 10 of the Examiner's Answer) that the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art counters the lack of a reasonable expectation of success is a non sequitur. First, there is no suggestion in the prior art, and the advantages 'proposed' by the Examiner would not flow naturally. Second, whether Appellants have 'recognized' other advantages has no bearing on whether there would be any expectation of success from the Examiner's combination.

With respect to the §103(a) rejections, Appellants continue to note that the references simply do not teach the claimed elements, and that there can be no motivation to combine these disparate references.

Claims 1, 13, and 23 require, *inter alia*, "the target devices are persistently and concurrently in communication with the server by means of a network." The Examiner correctly notes that Beelitz does not teach or suggest such an element, and instead cites to Cohn for such teachings. Specifically, the Examiner asserts that it "would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network." [sic] See, ¶5 of the September 20, 2005 office action.

The Appellants traverse the Examiner's assertion because Beelitz specifically and unequivocally teaches away from such a combination, there must be a reasonable expectation of success, and the mere ability to combine references is insufficient to support a rejection.

**Beelitz teaches away from the combination**

Beelitz teaches a generation of a compatible order for a computer system. The Beelitz system is for specifying, ordering, and building a build-to-order computer system, such that a purchaser of a build-to-order computer system can buy and order such a computer over a computer network such as the Internet. See, abstract, Beelitz.

Beelitz, teaches “[I]n step 207, control 103 *provides to the user interface 105* a list of the operating system types available.” (emphasis added) at column 7 55-56. Furthermore, “[I]n step 204, *control 103 accesses the master data base 125* to create or generate a list of operating system types available for the targeted computer system” (column 7 lines 35-37).

Control 103 “receives an indication *from a user interface 105* indicating the desire to purchase a computer system.” Column 7, lines 30-32 (emphasis added). Thus, control 103 is distinguished from the targeted computer system 137 (FIG. 1 of Beelitz) and the terminal or user interface 105 (FIG. 1 of Beelitz).

Beelitz teaches that it has been known to install software programs and to perform tests on computer systems *before they are shipped* to businesses or individual customers. The goal of software installation and testing, according to Beelitz, is to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. Beelitz, column 1, lines 56-61.

One of ordinary skill in the art would recognize that shipping a computer to a business or individual customer requires *disconnecting* any network connections used for software installation and testing. Those of ordinary skill in the art would also recognize that disconnecting a network connection terminates the connection, and therefore disconnecting a network connection is inconsistent with a persistent and concurrent network connection. Thus, one of ordinary skill in the art could not possibly be motivated to make the modifications suggested by the Examiner, as Beelitz unequivocally teaches away from the combination.

At most, Beelitz discloses that a targeted computer system 137 is initially booted up to perform the operations and instructions as per associated shell script files to load the selected programs onto its hard drive and to run the tests. In one embodiment, the selected software programs and operating systems can be down loaded and installed on the targeted computer system via the Internet. *See*, column 15, lines 1-7. Thus, Beelitz does not disclose “the target devices are persistently and concurrently in communication with the server by means of a network.” Beelitz teaches only loading and installing the operating system onto the targeted computer system, prior to disconnecting the network connection to enable the newly built-to-order computer to ship to a business or individual.

***There is no reasonable expectation of success***

Similarly, there is no reasonable expectation of success based on the combination of references. MPEP 2143.02, *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). Here, modifying the Beelitz system to feature “target devices [that] are persistently and concurrently in communication with the server by means of a network” would entirely defeat the purpose of Beelitz, and cannot lead to any reasonable expectation of success. Indeed, one of ordinary skill in the art would more likely find a reasonable expectation of *failure*.

The Examiner asserts that it “would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.” [sic] However, any such modification would in fact change the function or structure of the network, contrary to the Examiner’s assertions. The function and structure of the Beelitz network is to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. Beelitz, column 1, lines 56-61. Modifying the function or structure of the Beelitz network would not result in the claimed invention, but would rather result in a business or individual purchasing a built-to-order computer that is not

delivered to the purchasing business or individual, but rather a computer that remains at the factory, sitting on an assembly line.

**The mere ability to combine references is insufficient to support a rejection**

The mere fact that Beelitz can be modified in view of Cohn to obtain the claimed invention (which Appellants deny) does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The basis for the Examiner's assertion is that "it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network." (pg. 3, Sept. 20, 2005 office action). However, the Examiner simply cannot conclusively assert that an implementation of the allegedly persistent and concurrent communication with the server by means of a network taught by Cohn would permit the ability to efficiently produce a useful, reliable, computer system which may be *delivered* to businesses and individuals free from errors and ready to run. See, Beelitz, column 1, lines 56-61. Indeed, implementing a persistent and concurrent communication with a server, as allegedly taught by Cohn, would simply not work in a Beelitz system and would destroy the principle of operation of Beelitz.

Therefore, Appellants request the withdrawal of the rejections to claims 1, 13, and 23, as well as claims 2-9, 11-12, 14-22 and 24-27 depending directly or indirectly from one of claims 1, 13, or 23.

#### KSR

In the interim between the original appeal of this matter, and the filing of this reply brief, the United States Supreme Court decided the KSR case. The Supreme Court decision mandates reversal of the Examiner's rejections herein. However, Appellants have not previously analyzed the KSR decision, and address that case here.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." Furthermore, to facilitate review, this analysis should be made explicit. *Id.* (citing *In re*

*Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Were the combination of Beelitz and Cohn as ‘obvious’ as suggested by the Examiner those of skill in the art would have surely made the combination prior to the Appellants. This is especially true in a field as subject to rapid advancement and rapid innovation as the field of computer boots. As noted by the BPAI in *Ex Parte Catan*:

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). In determining this skill level, the court may consider various factors including “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Id.* (cited in *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995)). In a given case, every factor may not be present, and one or more factors may predominate. *Id.* at 962-63, 1 USPQ2d at 1201.

Thus, the Examiner’s *ad hoc* combination herein is not simply a matter of substituting one element for another element, but instead is an example of impermissible hindsight. The Examiner has ignored the mandatory *Graham* factors, and ignored the need to consider the person of ordinary skill in the art. Indeed, the Examiner’s *ad hoc* combination is utterly unsupportable based on the multiple teachings of Beelitz that teach away from a combination with Cohn.

Therefore, the Appellants respectfully request the Board reverse the Examiner’s rejections, and allow this matter to pass to issuance.

**SUMMARY**

The Appellants respectfully request maintenance of their appeal, and submit that claims 1-9 and 11-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **September 18, 2007**

Respectfully submitted,  
STEVEN M. FRENCH, *et al.*

/FRANK C. NICHOLAS/

CARDINAL LAW GROUP  
1603 Orrington Avenue, Suite 2000  
Evanston, IL 60201  
(847) 905-7111

---

FRANK C. NICHOLAS,  
Registration No. (33,983)  
Attorney for Appellants